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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,251	08/03/2001	Yoshio Harada	P21030	6273

7055 7590 10/04/2002

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EXAMINER
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SAVAGE, JASON L

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 10/04/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)
	09/890,251	HARADA ET AL.
	Examiner	Art Unit
	Jason L Savage	1775

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 2,3,9-12,14 and 16-18 is/are allowed.
- 6) Claim(s) 1,4-7,13 and 15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .	6) <input type="checkbox"/> Other: _____

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***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4, 5 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, line 2, there is no basis for the limitation 'the metal coatings'.

In claim 5, line 2, there is no basis for the limitation 'the middle layer'.

In claim 13, line 2, there is no basis for the limitation 'the middle layer'.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'467 (JP 10-045,467).

JP'467 teaches a substrate for a plasma treating vessel having a coating thereon which comprises  $Y_2O_3$  and  $Al_2O_3$  (abs.). JP'467 is silent to the method used to form the  $Y_2O_3$  containing coating; however claim 1 is drawn to the article, not the method of making. Absent a

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teaching of the criticality of the claimed method, it does not provide a patentable distinction over the prior art. When there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324.

Regarding claim 8, JP'467 is silent to the method used, however it does teach that the coating is a sintered compact (abs.). Absent a teaching of the criticality of forming the coating by spraying, it does not provide a patentable distinction over the prior art. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used any known method for forming a multiple oxide containing coating, including thermally spraying, in order to have formed a coating which was a sintered compact of oxide materials.

5. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahara et al. (US 6,383,964).

Nakahara teaches a coated member which exhibits high corrosion resistance in a plasma treatment vessel (col. 1, ln. 7-11). The coating may contain a mixture of  $Y_2O_3$  and  $Al_2O_3$  and has a porosity of not more than 2% (col. 5, ln. 1-13). Nakahara is silent to the method used to form the ceramic coating layer, however claim 1 is drawn to the article, not the method of making. Absent a teaching of the criticality of the claimed method, it does not provide a patentable distinction over the prior art.

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Regarding claim 7, Nakahara teaches the porosity of the coating is not more than 2% (col. 5, ln. 1-13) and that the thickness is as little as 1000  $\mu\text{m}$  (col. 18, ln. 41-50).

Regarding claim 8, Nakahara is silent to the method used, however is does teach that the coating is a sintered compact (col. 5, ln. 1-8). Absent a teaching of the criticality of forming the coating by spraying, it does not provide a patentable distinction over the prior art. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used any known method for forming a multiple oxide containing coating, including thermally spraying, in order to have formed a coating which was a sintered compact of oxide materials.

***Allowable Subject Matter***

6. Claims 2-3, 9-12, 14 and 16-18 are allowed.
7. Claims 4-6 13, 15 contain allowable subject matter but are currently rejected to under 35 USC 112.
8. The following is a statement of reasons for the indication of allowable subject matter: The prior art teaches coatings for plasma treating vessels wherein the coating comprises a surface layer of  $\text{Y}_2\text{O}_3$  having a porosity and thickness within the ranges claimed by Applicant. However; the prior art does not teach a coating containing a  $\text{Y}_2\text{O}_3$  surface layer which further contains an metal film undercoat or an undercoat with a middle layer formed between the undercoat and the  $\text{Y}_2\text{O}_3$  surface layer.

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9. Any inquiry to this communication or earlier communications from the Examiner should be directed to Jason Savage, whose telephone number is (703)305-0549. The Examiner can normally be reached Monday to Friday from 6:30 AM to 4:00 PM.

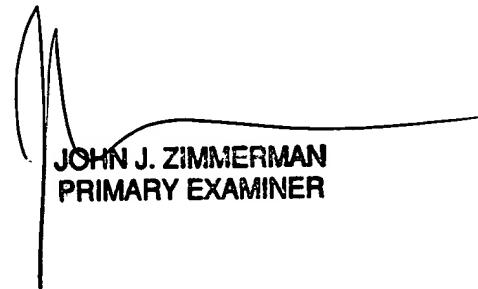
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on (703)308-3822.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-2351.



Jason Savage

10-1-02



JOHN J. ZIMMERMAN  
PRIMARY EXAMINER